

REMARKS

Claims 1 - 20 remain active in this application. Claim 5 has been amended. Support for the requested amendment is found on pages 11 - 13, Figure 7 and in claims 3, 4, 6, 7, 10, 13 and 16. No new matter has been introduced into the application.

Initially, it is respectfully noted that this application has now been pending in excess of five years. During that extended pendency, the application has received four consecutive non-final actions. All of these actions since the first office action have found the response fully persuasive, withdrawn the grounds of rejection stated in the previous action and stated new grounds of rejection. The present action also withdraws the grounds of rejection previously made and makes new rejections of all claims (including claim 6, previously indicated to be directed to allowable subject matter) based on Setlack et al. 6,259,804 which was first cited but not applied in the office action of March 24, 2004. Since the prosecution of this application has become protracted while, as will be demonstrated below, the Examiner continues to fail to address explicit recitations of the claims, close supervisory review as provided in M.P.E.P. §707.02 is respectfully requested.

Claims 1 - 7, 9, 10, 12, 15, 18 and 20 have been rejected under 35 U.S.C. §103 as being unpatentable over Setlack et al. 5,940,526 in view of Setlack et al. 6,259,804 and claims 8, 11, 13, 14, 16, 17 and 19 have been rejected under 35 U.S.C. §103 as being unpatentable over Setlack et al. 5,940,526 in view of Fujiwara et al. These grounds of rejection are respectfully traversed.

The invention is generally directed to the problem of removing static electricity from the hand or finger of a person to be identified by a fingerprint reading

apparatus so that the fingerprint reading apparatus will not be damaged or caused to respond incorrectly by discharge of static electricity to the fingerprint reading apparatus, itself. While numerous static electricity discharge arrangements are known, a degree of unreliability has persisted in known arrangements due to the variability (e.g. pressure, position, etc.) with which a user may touch or otherwise engage the structure for discharging static electricity. The invention seeks to improve the reliability of the static electricity discharging function while increasing convenience to the user by arranging static electricity discharging structure in locations where the finger of the user will reliably and firmly engage it during a natural action by the user. Specifically, all claims other than method claims 5 and 6 as currently rejected explicitly recite a plate adjacent to the fingerprint reading portion or adjacent to the cover for the fingerprint reading device or on which a finger must be placed to open the cover. (This latter recitation has been added to claim 5, from which claim 6 depends, by the above amendment.) While static electricity may be discharged in part through provision of a conductive cover, the invention also provides a plate which must be firmly engaged by the finger of a user *in order to open the cover or in the course of doing so*. See, for example, page 9, lines 11+, and page 10, lines 9 - 11. This feature of the invention is not taught or suggested in any prior art of record including that currently applied against the claims and the statement of the current grounds of rejection is silent in regard thereto.

The Examiner admits that Setlack '526 does not teach or suggest discharging static electricity while obtaining access to the fingerprint reading apparatus but cites Setlack '804 for teaching discharge of static electricity through a conductive cover (which is also

in parallel with the discharge path from pad 53 and while it serves to bleed static charge from the finger is not connected to ground but, rather, to a resistor 104 across which the signal of interest is developed). Fujiwara et al. is cited only for teaching use of a conductive resin and is not asserted to mitigate any other deficiency of Setlack et al. '526 (including that admitted in regard to independent claims 1, 2, 5, 7 and 10 and which also appear to apply to independent claims 13, 16 and 19 although Setlack et al. '804 is not included in the rejection thereof).

However, the Examiner does not address the claimed feature of the invention of providing static electricity discharging structure which must be firmly touched in the course of opening the cover and explicitly recited in various ways in all claims in the application. Specifically, the respective independent claims recite this feature in the language (emphasis added):

"removing said static electricity stored on a finger of a user through a plate on said fingerprint-reading apparatus adjacent said fingerprint-reading portion prior to putting his finger on a fingerprint-reading portion while obtaining access to said fingerprint-reading portion by movement of a structure for covering said fingerprint-reading portion when not in use" (Claim 1);

"removing said static electricity stored on said finger of a user through a plate adjacent said cover when said cover is opened" (Claim 2);

"removing said static electricity stored on said finger of a user through a conductive device which is connected to ground and on which a finger is placed when said user opens a main cover" (Claim 5);

"a plate electrically connected with a ground and positioned adjacent said cover such that said plate is touched by said finger prior to said finger touching said fingerprint-reading portion as said cover is opened" (Claim 7);

"a plate on which said finger is put to open said cover" (Claim 10);

"a cover which closes said fingerprint-reading portion when said fingerprint-reading portion is not used, and is opened by said finger when said finger is put on said fingerprint-reading portion, and

"a plate adjacent said cover

"wherein said cover and said plate are formed of conductive material and connected with a ground" (Claim 13);

"a plate on which said finger is put to open said cover" (Claim 16); and

"a lock-releasing button which locks said main cover relative to said main body so that said main cover closes said main body, and unlocks said main cover in order to open that,

"wherein said lock-releasing button is formed of conductive material and connected with ground" (Claim 19).

In summary, there is no teaching or suggestion whatever in the prior art of record that a cover can be used to regulate the engagement of a finger with structure other than the cover for discharging static electricity and the prior art provides no evidence of a level of ordinary skill in the art which would support a conclusion of obviousness of any modification of any prior art of record to answer such recitations. Accordingly, it is clear that the Examiner has, once again, failed to make a *prima facie* demonstration of

obviousness of any claim or even answered the basic concept of the invention which achieves improved reliability of discharge of static electricity but, rather, has continued to ignore explicit recitations of the claims which directly support that meritorious effect. That is, while Setlack et al. '804 may teach the use of a conductive cover for discharging static electricity from the finger of a user, it does not teach or suggest the *interaction* of a user's finger with a cover to cause improved contact and reliability of discharge of static electricity through *other* structure, as recited in all claims, as demonstrated above. Moreover, the Examiner has not even applied Setlack et al. '804 to all of the claims even though all claims in the application recite such a feature.

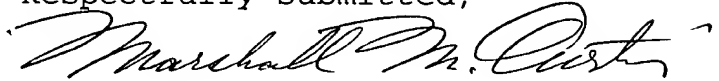
Accordingly, it is respectfully submitted that the currently asserted grounds of rejection are clearly in error and untenable. The recitations of the claims are not answered by teachings or suggestions of the prior art relied upon and, moreover, the prior art does not provide evidence of a level of ordinary skill in the art which would support a conclusion of obviousness since the prior art does not lead to an expectation of success in achieving the meritorious effects of the invention by use of the structure or method claimed. Therefore, upon reconsideration, withdrawal of the currently asserted grounds of rejection is respectfully requested.

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered and shown to be in error and/or inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 C.F.R. §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such

action is therefore respectfully requested.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Marshall M. Curtis".

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